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Robert Levin

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EXAMINER

COLLINS, DOLORES R

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/787,486
Filing Date: February 24, 2004
Appellant(s): LEVIN, ROBERT

Grace J. Fishel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/14/11 appealing from the Office action mailed 7/6/11.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claim 1.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Based upon consideration of all the relevant factors with respect to the claims as a whole, Claim(s) 1 is held to claim an abstract idea, and is rejected as ineligible subject matter under 35 U.S.C. 101.

The rationale for this finding is explained below, which is a result of careful consideration of the listed factors when analyzing the claims as a whole to evaluate whether a method claim is directed to an abstract idea. These factors are not intended to be exclusive or exhaustive.

I. Factors weighing toward eligibility are:

a) Recitation of a machine or transformation: In particular, machine or transformation meaningfully limits the execution of the steps, a machine implements the claimed steps, the article being transformed is particular, an object or substance, the article undergoes a change in state or thing (objectively different function or use);

b) Practically applying a law of nature to meaningfully limit the execution of the steps; or

c) The claim is more than a mere statement of a concept: It describes a particular solution of the problem to be solved; implements a concept in a tangible way, performance of steps are observable and verifiable.

II. Factors weighing against eligibility are:

a) No recitation or insufficient recitation of a machine or transformation:

+ Insufficient involvement of the machine or transformation, merely nominally, insignificantly, or intangibly related to the performance of the steps, (e.g., data gathering, or merely recites a field in which the method is intended to be applied).

+ Machine is generically recited such that it covers any machine capable of performing the claimed step(s) or merely an object on which the method operates.

+ Transformation involves only a change in position or location of the article.

b) Improperly applying a law of nature that would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature); or applied in a merely subjective determination or merely nominally, insignificantly, or tangentially related to the performance of the steps; or

c) The claim is a mere statement of a general concept: Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept; or both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus; or states only a problem to be solved; or general concept is disembodied; or mechanism by which the step(s) are implemented is subjective or imperceptible.

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+ Examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or relationships, teaching concepts, human behavior, and instructing how business should be conducted.

Claim 1 is ineligible subject matter because the claimed limitations include no recitation or insufficient recitation of a machine or transformation, not directed to a proper application of a law of nature, and is just a mere statement of a general concept.

In this case, the fact that no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are indicators that applicant is attempting to patent an abstract idea. None of the steps are performed by a machine, but rather are performed by a human being.

(10) Response to Argument

Applicant has amended claim 1 and cancelled claim 3 in an effort to overcome the rejection under 35 USC 101. Applicant has further argued case law upon which the rejection under 35 USC 101 relies. In response to Applicant's argument, the Supreme Court did indicate that the machine or transformation test is "not the sole test for patent eligibility", but that it may be a "useful and important clue or investigative tool" for deciding whether an invention is a patent eligible process under 35 USC 101. In this case, the facts that no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are indicators that applicant is attempting to patent an abstract idea. None of the steps are performed by a machine, but rather are performed by a human being.

Applicant's claimed method, while arguably reciting a number of physical steps, is viewed here as an attempt to claim a new set of rules for playing a game. In this examiner's opinion, a set of rules qualifies as an abstract idea. Therefore, the examiner maintains that Applicant's claimed method, although couched in terms of a few actual physical steps, is a clear attempt to claim an abstract idea in the form of a new set of rules for playing a card game. Since the claimed method requires no machine implementation, requires no transformation of a particular article and is seen as an attempt to receive patent protection for an abstract idea in the form of a new set of rules, the examiner maintains that the claimed method is not patent eligible.

It is noted here that several factors weighing toward and against patent eligibility have been analyzed by the examiner, including but not limited to the machine and transformation factors and the abstract idea or general concept factors discussed above. See the Federal Register notice entitled "Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos* (Fed. Reg. Vol. 75, No. 143/Tuesday, July 27, 2010/Notices) for a complete list of factors that were considered by the examiner in the above analysis. Specifically, the lack of implementation by a particular machine or the transformation of a particular article, the lack of a meaningful limit imposed by the device or table and the apparent attempt to claim an abstract idea in the form of a new set of rules are all factors that weigh against eligibility. The fact that the claim may be more than a mere statement of a concept in that an actual method of playing the game is claimed versus just a new set of rules may be a factor weighing towards patent eligibility. However, in this case that factor

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weighing towards eligibility is not given much weight since the use of the concept, as expressed in the method, would effectively grant a monopoly over the concept. It is this examiner's opinion that the factors in this case weighing against patent eligibility far outweigh the factors weighing toward patent eligibility. The rejection of claim 1 under 35 USC 101 as directed to non-statutory subject matter is maintained for the above reasons.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DOLORES COLLINS/

Examiner, Art Unit 3711

Conferees:

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

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